

REMARKS

Reconsideration of the present application is respectfully requested. The abstract and specification has been amended to conform with the Examiner's objections. No new matter has been added. Claims 4 and 5 have been amended to conform with the Examiner's objection to the word "unhiding." Claims 1 and 15 have also been amended. Claims 1-21 are currently pending.

Claim Objections

Claims 6, 7, 13, 14, 20, and 21 are objected to for improper dependent format. Applicants respectfully submit that claims 6, 7, 13, 14, 20, and 21 are similar to an acceptable product-by-process claim in that they define an encoded computer program which is executable on a computer to perform the methods set forth in independent claims 1, 8, and 15. The methods are thus physically embodied in an encoded computer program. Claims 6, 7, 13, 14, 20, and 21 are proper in their construction in that they reference and are dependent from previous claims 1, 8, and 15, and still further define the product created having embodied thereon the methods in claims 1, 8, and 15. Moreover, the metes and bounds of claims 6, 7, 13, 14, 20, and 21 are clearly set forth in the methods of claims 1, 8, and 15 from which they depend.

The fourth paragraph of 35 U.S.C. §112 requires "a claim in dependent form shall contain a reference to a claim previously set forth and then specify a further limitation of the subject matter claimed." Claims 6, 7, 13, 14, 20, and 21 satisfy this statutory requirement. Claims 6, 7, 13, 14, 20, and 21 are written in a format that defines, in dependent form, an encoded computer program to perform a method, thus enabling the performance of the methods set forth in claims 1, 8, and 15.

The format of claiming a computer-readable medium with instructions to perform a method, or a computer programmed to perform the method, was approved in *In re Beauregard*, 35 USPQ2d 1383 (Fed. Cir. 1995). The primary difference between the *Beauregard* claims and claims 6, 7, 13, 14, 20, and 21 is that these claims are written in a dependent format. Often this format raises an initial concern because the preambles of the dependent claims differ from the base claims. However, the present dependent claims also comply with a format approved by the Board of Patent Appeals and Interferences in *Ex parte Adrianus P.M.M. Moelands*, 3 USPQ2d 1474 (PTO Board of Pat App and Int 1987). In *Moelands*, the Board upheld as appropriate the following dependent claim to a data transmission system:

11. A data transmission system comprising:
 - at least two of the data transmission stations of claim 10;
 - a clock bus interconnecting the clock terminals of the stations; and
 - means which maintain the clock bus at the second voltage level in the absence of forcing by the stations.

Although the preamble in *Moelands*' claim 11 to a "data transmission system" is different than the preamble in claim 10 to a "data transmission station", the Board held that this dependent claim format satisfies the statutory requirements of both the second and fourth paragraphs of 35 U.S.C. §112.

Accordingly, claims 6, 7, 13, 14, 20, and 21 are in an acceptable dependent format and are in condition for allowance. Applicants respectfully request that the objection to claims 6, 7, 13, 14, 20, and 21 be withdrawn.

Rejections based on 35 U.S.C. § 102

Claims 1-7 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Oran et al., U.S. Patent No. 5,617,526 (“Oran”). Applicants respectfully traverse this rejection because Oran does not teach “monitoring an interval of time associated with an activity of the item” as recited in amended claim 1.

Oran discloses techniques for providing a notification area to display visual notifications to a user. Icons displayed within the notification area may provide interactive information in response to a user input, and applications may perform activities, such as the opening of an application window, in response to the user using the mouse to double-click on the icon.

In contrast, independent claims 1, as amended, recites “monitoring an interval of time associated with an activity of the item.” Oran does not teach such monitoring. Accordingly, Applicants submit that independent claim 1 is in condition for allowance. Furthermore, Applicants submit that dependent claims 2-7, which depend from claim 1, are in condition for allowance for at least the same reasons discussed above with respect to claim 1.

Rejections based on 35 U.S.C. § 103

Claims 8-14 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Oran in view of Gorbet et al., U.S. Patent No. 6,542,463 (“Gorbet”). Claims 15-18 and 20-21 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Oran and further in view of Chari et al., U.S. Patent No. 6,553,416 (“Chari”). Claim 19 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Oran and Chari, and further in view of Brown et al., U.S. Patent No. 5,673,403 (“Brown”).

Claims 8-14

Claims 8-14 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Oran in view of Gorbet. Applicants respectfully traverse this rejection because Gorbet is disqualified from assertion as prior art against the present application.

Subject matter which only qualifies as prior art under 35 U.S.C. §102(e),(f), or (g) is disqualified as prior art “if that subject matter and the claimed invention ‘were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.’” MPEP § 706.02(l)(1) (*quoting* 35 U.S.C. §103(c)). Gorbet was filed on May 5, 1999 and does not claim an earlier priority date. Gorbet was published on September 12, 2002 and issued on April 1, 2003. The present application was filed on April 4, 2001, and claims the benefit of a provisional application filed on April 6, 2000. Considering the foregoing, it is clear that Gorbet is prior art to the present applicant only under 35 U.S.C. §102(e).

The present application and Gorbet were, at the time of the invention of the present application, owned by or subject to an obligation of assignment to the Microsoft Corporation of Redmond, Washington. Accordingly, Gorbet is disqualified as prior art against the present application. *See* MPEP § 706.02(l)(2). Applicants submit that claims 8-14 are in condition for allowance and request such allowance.

Claims 15-18 and 20-21

Claims 15-18 and 20-21 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Oran and further in view of Chari. The Office Action states, “[Oran does] not teach the display of descriptions associated with notifications and options for configuring notification

items. Chari et al. teaches a system capable of managing and displaying notifications similar to that of Oran et al.” Applicants respectfully traverse the rejection because the proposed combination of Oran and Chari fails to disclose each and every limitation of the claimed invention.

As discussed previously, Oran discloses techniques for providing a notification area to display visual notifications to a user. Chari teaches an apparatus which alerts an operator that an event has occurred on a computer component. The apparatus allows a user to select which alerts to enable and which alerts to disable. When enabled, alerts are presented in a consistent manner, without varying behavior characteristics.

In contrast, independent claim 15, as amended, recites “displaying the notification item icon, a description associated with the notification and a hiding behavior characteristic to be associated with the notification item.” Neither Oran nor Chari, alone or in combination, teach displaying such information. Accordingly, Applicants submit that independent claim 15 is in condition for allowance. Furthermore, Applicants submit that dependent claims 16-18 and 20-21, which depend from claim 15, are in condition for allowance for at least the same reasons discussed above with respect to claim 15.

Dependent Claim 19

Claim 19 stands rejected as being unpatentable under 35 U.S.C. §103(a) over Oran and Chari, and further in view of Brown. Oran and Chari have been discussed above. Applicants respectfully traverse the rejection because the proposed combination of Oran, Chari, and Brown fails to disclose each and every limitation of the claimed invention.

Claim 19 depends from independent claim 15. As discussed above, claim 15 is patentable over Oran and Chari. Brown also fails to disclose the invention of claim 15, either individually or in combination with Oran and Chari. Claim 19 includes all of the limitations of claim 15 and is also patentable over Oran, Chari, and Brown, taken individually or in combination with one another, for at least the reasons stated above.

Conclusion

For the reasons stated above, claims 1-21 are in condition for allowance. Applicants respectfully request withdrawal of the pending rejections and allowance of claims 1-21. If any issues remain which would prevent issuance of this application, the Examiner is urged to contact the undersigned prior to issuing a subsequent action. The Commissioner is hereby authorized to charge any additional amount required, or credit any overpayment, to Deposit Account No. 19-2112.

Respectfully submitted,



Scott Strohm
Reg. No. 42,172

SHOOK, HARDY & BACON L.L.P.
One Kansas City Place
1200 Main Street
Kansas City, Missouri 64105-2118
Phone: 816/474-6550
Fax: 816-421-5547